



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/520,476 03/08/00 MALIK A 04906-013843

┌

IM22/0814

└

JACQUES M DULIN ESQ
PILLSBURY MADISON & SUTRO
TEN ALMADEN BLVD
8TH FLOOR
SAN JOSE CA 95113

EXAMINER

WILSON, D

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED:

5
08/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/520,476

Applicant(s)

MALIK ET AL.

Examiner

D. R Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☒ Interview Summary (PTO-413) Paper No(s). 2.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Priority

1. Applicant's reference to the parent applications to Serial No. 08/08/477,168 under "Cross Reference to Related Applications" is not in compliance with CFR 1.78(2). All of the parent applications need to be recited in the first sentence which should be directly under the title and not under a heading "Cross Reference to Related Applications".

Oath/Declaration

2. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. A supplemental oath or declaration is required under 37 CFR 1.67. Reference to the subject matter to which the declarants believe they are the first and sole inventors does not include the instantly claimed elastomers. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Objection to New Matter

3. The amendment filed 3/8/00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

4. Applicant has referred to no basis for the amendment adding new subject matter to the specification and claims.

Each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment. See 37 CFR 1.121 (b)(2)(iii)

The Examiner acknowledges a basis for most of the amendments to the specification as being the same as in the parent applications. However, it is not clear that there is a basis for the paragraph inserted at page 56 of the specification and the claims, especially regarding the definitions of "X", "Y" and "Z".

Art Unit: 1713

Applicant is required to point out the bases for the amendment and the claims or cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112, First Paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 20-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter in question is that discussed in the preceding section.

7. Claims 20-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for elastomers having "random" FOX and THF segments, does not reasonably provide enablement for other types of FOX/THF segments. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention commensurate in scope with these claims. The specification specifically teaches that the co-prepolymers are random as opposed to block copolymers and that this is an important distinction (page 39, lines 13-15, and page 44, lines 18-26).

8. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain crosslinking agents, does not reasonably provide enablement for compounds identified only by tradenames. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention commensurate in scope with these claims. Isonol 93 and "Jeffamines" are recited in the claims and the specification (page 56) without a specific chemical description. The relationship between a trademark or tradename and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact,

Art Unit: 1713

intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. >Ex Parte Kattwinkle, 12 USPQ 11 (Bd. Apps. 1931).< Where the identification of a trademark is introduced by amendment it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.

Claim Rejections - 35 USC § 112, Second Paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claims 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. The language of Claim 20 is indefinite because "FOX" and "THF" are not defined. From the language of the claim none of the structural units shown need in fact be a FOX, THF or FOX/THF segment, which does not appear to be the intent of applicant. The language is also indefinite because of the confusing language of the Markush group defining "R_f". It is suggested that language such as is used in applicant's U.S. Patent 5,703,194 be used which appears to have the same meaning, i.e.,

"---- R_f is selected from the group consisting of linear and branched perfluorinated alkyls having 1-20 carbons, and oxaperfluorinated polyethers having from about 4-20 carbons".
 - b. The language of Claim 23 is indefinite because there is no antecedent basis for "said isocyanate segment".
 - c. The language of claim 24 is indefinite because said elastomer does not contain a cross-linking agent. However, it may "further contain cross-links". Additionally, the parenthetical expressions following "polymeric HDI" makes the term indefinite because it is not known how it further limits polymeric HDI". Further, it is not known what is meant by "saturated MDI". Presumably applicant means "hydrogenated MDI" as shown on page 48.
 - d. Claim 25 is indefinite because it is not known what is included in the terms Isonol™ 93 or Jeffamines. The tradenames used in this claim are indefinite for reasons discussed above.

Art Unit: 1713

- e. Claim 28 is indefinite because there is no antecedent basis for "said fluorinated segment".

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 20-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,703,194. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in scope. The additional features of chain-extendors and cross-linking agents would have been considered obvious to one of ordinary skill in the field of thermoset polyurethanes. In regards to instant Claim 23, it would have been considered obvious that a thermoplastic elastomer could be prepared by omitting the presence of a cross-linking agent.

13. Applicant is also advised that should claim 26 be found allowable, claim 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

14. Claims 26-28 are objected to because of the following informalities:

Art Unit: 1713

- a. In claims 26-27, "1,3-propanediol", "1,4-butanediol" and "benzenedimethanol" should each be one word. Appropriate correction is required.
- b. In Claim 28, line 5, "3,3-" at the end of line should obviously be "3-".

Art of Interest/Technological Background

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hargis discloses polyurethane elastomers of prepolymers derived from oxetanes with monoperfluoro-substituted oxetanes such as are used by applicants. The Examiner needs to determine if these teachings are in the parent application to Hargis (which is a CIP). However, the parent application of Hargis is not available at this time to the Examiner.

Other Comments

16. The amendment to page 51, line 51, could not be entered due to faulty instructions.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R Wilson whose telephone number is 703-308-2398. The examiner can normally be reached on 5-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R Wilson
Primary Examiner
Art Unit 1713

August 9, 2000